UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/123,253	07/27/98	HUTCHENS	T	D-5639-C4

IM62/0717

PATENT DEPARTMENT
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EXAMINER	
ALEXANDER, L	
ART UNIT	**PAPER NUMBER**
1743	13

DATE MAILED: 07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
09/123,253	Hutchens et al.
Examiner	**Group Art Unit**
Lyle A. Alexander	1743

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☐ expires _____ months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due two months from the date of the Notice of Appeal filed on *Jul 12, 2000* (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *Jul 6, 2000* has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

☒ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☒ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: *The issue of macromolecules has not been previously considered and would require further search and consideration.*

☐ Applicant's response has overcome the following rejection(s):

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *none*

Claims objected to: *none*

Claims rejected: *49-113*

☐ The proposed drawing correction filed on _____ ☐has ☐has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☒ Other *See the attached paper.*

LYLE A. ALEXANDER
PRIMARY EXAMINER
ART UNIT 1743

1. Applicant's arguments filed 7/6/00 have been fully considered but they are not persuasive.

Applicants have indicated a terminal disclaimer was submitted with the 7/6/00 response. However, there is no disclaimer in this file. Could Applicants please resubmit the terminal disclaimer.

Applicants state Van Breemen et al. teach desorption and detection of salts with small amu and cannot be read on the claimed desorption/detection of macromolecule. These limitations have not been entered. Even if they were entered, it would be helpful if a Declaration were supplied stating Van Breemen could not be used to desorb macromolecule and better define the relative sizes of the claimed macromolecule as compared to the salts taught by Van Breemen et al.

Applicants state Stuke does not teach the claimed probe having a non-metal surface. The Office agrees and will reconsider this rejection upon further appeal.

Applicants state Zare et al. teach use of multiple energy sources for desorbing and ionizing the analyte which cannot be read on the instant invention that teach a single energy source. The instant claim language is open and does not exclude addition energy sources. Even if the language were close to exclude addition energy sources, the Office would maintain that one of ordinary skill in the art would have expected similar results from use multiple energy sources to achieve the expected function of sample desorption (e.g. a rejection under 35 USC 103). A showing of unexpected results would be helpful to overcome this reference.

Under 35 USC 103 Applicants make similar arguments with respect to Van Breemen et al. relating to the macromolecule limitation which have been covered above. Applicants state it would not have been obvious to modify Stuke or Turteltaub to use affinity binding techniques. The Office may agree to this statement but does not see this limitation in the pending claims.

Any inquiry concerning this communication should be directed to Lyle A. Alexander at

telephone number (703) 308-3893.

LYLE A. ALEXANDER
PRIMARY EXAMINER